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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/973,225      | 10/09/2001  | Rene Kagi            | 7041.P32CIP         | 2399             |

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EXAMINER

LUGO, CARLOS

ART UNIT

PAPER NUMBER

3677

DATE MAILED: 09/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                         |                  |
|------------------------------|-------------------------|------------------|
| <b>Office Action Summary</b> | Application No.         | Applicant(s)     |
|                              | 09/973,225              | KAGI, RENE       |
|                              | Examiner<br>Carlos Lugo | Art Unit<br>3677 |

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)  Responsive to communication(s) filed on 10/09/01

2a)  This action is FINAL.      2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)  Claim(s) 1-9 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-9 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 09 October 2001 is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)  All    b)  Some \*    c)  None of:

        1.  Certified copies of the priority documents have been received.

        2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

        3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    \* See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)      4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.

2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)      5)  Notice of Informal Patent Application (PTO-152)

3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.      6)  Other: \_\_\_\_\_.

## DETAILED ACTION

### *Oath/Declaration*

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application-by-application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

- It does not state that the person making the oath or declaration has reviewed and understands the contents of the specification, including the claims, as amended by any amendment specifically referred to in the oath or declaration.
- It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56.

### *Specification*

2. The specification is objected to because of the following informalities:

- Page 7 Line 7, change "he" as --the--.
- Claim 6 Line 2, change "sone" as --cone--.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

- The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**4. Claim 6 is rejected** under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

For example, claim 6 recites that the flange of the end tube or threaded bolt is positioned into the hole. However, the specification fails to disclose how this flange will maintain a sealing arrangement.

**5. The following is a quotation of the second paragraph of 35 U.S.C. 112:**

- The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

**6. Claims 1-9 are rejected** under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1 and 2, the phrase "or" (in the preamble) renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Claim 1 recites the limitation "the hole" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites the limitation "the wall of the hole" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim 2 recites the limitation "the diameter of the drill hole" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 2 recites the limitation "the rim zone" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 2 recites the limitation "the wall" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim 3 recites the limitation "two or more elements" in line 1. There is insufficient antecedent basis for this limitation in the claim. Also, it is unclear if these elements are different from the first element claimed in claim 2.

Claim 3 recites the limitation "two outer elements" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 4 recites the limitation "can shaped". It is unclear which shape does the invention has because claim 4 depends from claim 2, wherein claims that the element has a cone or dome shape.

Claim 4 recites the limitation "the rim of the hole" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 4 recites the limitation "the bottom of this element" in lines 2 and 3. There is insufficient antecedent basis for this limitation in the claim. Also, it is unclear to which element is referring.

Regarding claim 6, the phrase "or" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

As to claim 8, it is unclear what the applicant is claiming as his invention.

***Double Patenting***

7. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states, "whoever invents or discovers any new and useful process ... may obtain a patent therefore..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

8. **Claims 1-9 are provisionally rejected** under 35 U.S.C. 101 as claiming the same invention as that of claims 1-9 of copending Application No. 09/908339. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**10. Claims 1,2,5 and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat No 859,733 to Bot.**

Regarding claims 1 and 2, Bot discloses a method of sealing applying axial pressure on an element (4) placed in a hole (3). The element is temporally supported in the hole. The element has a disc shaped surface with a rim with a diameter smaller than the diameter of the hole. The element has a cone or dome shaped configuration. The axial pressure will achieve radial expansion of the element rim and a press fit with a wall of the hole (lines 45-47).

As to claims 5,8 and 9, Bot illustrates that the element is a perforated disc with a cone or dome shape.

As to claim 7, Bot discloses that the element shoe close to the rim of the hole.

**11. Claims 1,2,5 and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat No 3,038,456 to Dreisin.**

Regarding claims 1 and 2, Dreisin discloses a method of sealing applying axial pressure on an element (28) placed in a hole (29). The element is temporally supported in the hole. The element has a disc shaped surface with a rim with a diameter smaller than the diameter of the hole. The element has a cone or dome shaped configuration. The axial pressure will achieve radial expansion of the element rim and a press fit with a wall of the hole.

As to claims 5,8 and 9, Dreisin illustrates that the element is a perforated disc with a cone or dome shape.

As to claim 7, Dreisin discloses that the element shoe close to the rim of the hole.

**12. Claims 1,2,5 and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat No 2,781,943 to Carlstrom.**

Regarding claims 1 and 2, Carlstrom discloses a method of sealing applying axial pressure on an element (14) placed in a hole (50). The element is temporally supported in the hole. The element has a disc shaped surface with a rim with a diameter smaller than the diameter of the hole. The element has a cone or dome shaped configuration. The axial pressure will achieve radial expansion of the element rim and a press fit with a wall of the hole.

As to claims 5,8 and 9, Carlstrom illustrates that the element is a perforated disc with a cone or dome shape.

As to claim 7, Carlstrom discloses that the element shoe close to the rim of the hole.

**13. Claims 1,2,5 and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat No 2,058,452 to Hoffman.**

Regarding claims 1 and 2, Hoffman discloses a method of sealing applying axial pressure on an element (11) placed in a hole (9). The element is temporally supported in the hole. The element has a disc shaped surface with a rim with a diameter smaller than the diameter of the hole. The element has a cone or dome shaped configuration. The axial pressure will achieve radial expansion of the element rim and a press fit with a wall of the hole.

As to claims 5,8 and 9, Hoffman illustrates that the element is a perforated disc with a cone or dome shape.

As to claim 7, Hoffman discloses that the element shoe close to the rim of the hole.

**14. Claims 2 and 4 are rejected** under 35 U.S.C. 102(b) as being anticipated by US Pat No 4,601,475 to Nicholson.

Regarding claim 2, Nicholson discloses a method of sealing applying axial pressure on an element (3) placed in a hole (2a). The element is temporally supported in the hole. The element has a disc shaped surface with a rim with a diameter smaller than the diameter of the hole. The element has a cone or dome shaped configuration. The axial pressure (applied by the pipe 1) will achieve radial expansion of the element rim and a press fit with a wall of the hole.

As to claim 4, Nicholson discloses that the element comprises an outer shoulder to sit on the rim of the hole.

***Claim Rejections - 35 USC § 103***

**15.** The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**16. Claims 3 and 6 are rejected** under 35 U.S.C. 103(a) as being unpatentable over US Pat No 2,058,452 to Hoffman in view of US Pat No 3,469,490 to Pearce.

Regarding claim 3, Hoffman fails to disclose that the element (11) is composed by two or more elements.

Pearce teaches a bolt for a seal arrangement with a surface. The sealing arrangement includes an outer element (24), a middle element (25) and an inner element (26). The middle element could be a resin (Col. 4 Lines 41-46).

As to claim 6, Hoffman fails to disclose that the element (11) and the bolt (10) are a one-piece construction.

Pearce teaches that a bolt (22) having an integral flange (24) is known in the art.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a sealing arrangement, as taught by Pearce, into a sealing device as described by Hoffman in order to provide a better sealing engagement between the bolt and the hole.

### ***Conclusion***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents cited further show the state of the art with respect to seals.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lugo. The examiner phone number is (703)-305-9747. The fax number for correspondence before a final action is (703)-872-9326 and the fax number for correspondence after final action is (703)-872-9327. The email direction of the examiner is carlos.lugo@uspto.gov. The examiner can normally be reached on Monday to Friday from 9:30am to 6:30pm (EST). If the examiner is not available, please leave a message, including the application number and the examiner will answer the message as soon as possible.

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August 19, 2002



ROBERT J. SANDY  
PRIMARY EXAMINER